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09/576,386	05/22/2000	William T. Carden JR.	35672-163980	1657

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EXAMINER
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HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/576,386

Applicant(s)

CARDEN, WILLIAM T.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Petition Granted filed on 8/15/01.
2. Claims 1 – 20 are pending in the case. Claims 1, 13, and 18 are independent.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 17, respectively of copending Application No. 09/501,169. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention to know that in a peer-review publishing system, as claimed in both applications, that collaboratively reviewing documents is inherent, that editing the reviewed document is an obvious implementation because users of the system would like the document reviewed by peers and fixed if necessary prior to publishing, that assigning a plurality of reviewers as opposed to just one reviewer is obvious because users of the system

would prefer different points of view, and that storing and retrieving a document to and from a database is obvious because the users of the system may not be able to coordinate access to the document especially if located remotely.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 – 17, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding independent claim 1, the metes and bounds of “collaboratively” in line 7 are unclear. All subsequent recitations of “collaboratively” are also rejected. Therefore, the Office will not consider the term for purposes of this examination.

8. Claim 12 recites the limitation "said browser" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Regarding independent claim 13, the metes and bounds of “collaboratively” in line 16 are unclear. All subsequent recitations of “collaboratively” are also rejected. Therefore, the Office will not consider the term for purposes of this examination.

10. Regarding dependent claim 17, it is unclear what applicant means by “an editor center” in line 8.

11. Regarding dependent claim 19, it is unclear what applicant means by "standardized code" in line 9. Further, it is unclear what applicant means by "comparing same" in line 5.

12. Regarding dependent claim 20, it is unclear what applicant means by "a draft center" in line 1.

13. Regarding dependent claims 2 – 11 and 14 – 16, the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1 – 5 and 8 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (US006374274B1).

16. **Regarding independent claim 1**, Myers et al. teach that *a network database system wherein clients of subscribing entities are authorized network access to reliable documents* (see Abstract and Fig. 1), which provides for **a database adapted to store a plurality of documents; a plurality of computers, each of which is adapted to be coupled to said database; and a network connecting said plurality of computers together for communication of data relating to said plurality of documents among said plurality of computers and said database**. Myers et al. teach *receiving and processing data from a provider* (Col. 3, lines 4 and 5), which provides a **means for**

**submitting a new document to said database.** Myers et al. also teach that *anything that is stored in the practitioner/client database(s) can be displayed on the document pages* (Col. 7, lines 41 – 42), which provides a **means for collaboratively reviewing said new document.** Myers et al. further teach a *plurality of document files* in which *map files define links to related documents* (Col. 4, lines 2 – 5), which provides a **means for relating said new document to said plurality of documents.** Myers et al. also teach that *one application of information retrieval systems is to provide (by display, printing, or other appropriate means) a collection of documents that is directed to a particular field, so that a particular set of authorized users can select and retrieve a desired portion of the collection* (Col. 1, lines 18 – 22), which provides a **means for publishing a journal of a selected portion of said plurality of documents.** Myers et al. do not explicitly teach **editing said reviewed new document.** However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a **means for editing said reviewed new document,** in view of Myers et al. teaching that *features that can be included in the system are customization of the documents to reflect sourcing by particular subscribers, automated formatting of the documents for storing in a network database* (Column 2, lines 32 – 35).

17. **Regarding dependent claims 2 and 3,** Myers et al. teach that *appropriate coding for passing the username and password into the appropriate header field of the subscriber's or client's web browser is included in the ODBC program module of the primary server 22A, the details of such code being within the skill of the web-server programming art* (Col. 6, lines 35 – 40), which, along with Figure 1, provides that a

**plurality of computers comprises a server and a plurality of clients and the server comprises a web server and said plurality of clients each further comprise a browser.**

18. **Regarding dependent claim 8**, Myers et al. teach that *a suitable primary server can be implemented with the server computer running MICROSOFT SQL SERVER 6.5* (Col. 3, lines 53 – 68), which the skilled artisan knows provides that **the server further comprises means for searching said database.**

19. **Regarding dependent claims 4, 5, and 9**, Myers et al. teach that *the convert article step 70 first finds and replaces embedded tags of the current raw article file with corresponding HTML commented tags in a convert tags step 98. Text that is delimited with special characters is located, and corresponding HTML delimiters are substituted therefor in a special text step 100. Particularly, bolded text in the raw ASCII files is delimited by brackets (" . . . [bolded text] . . . "), being changed by the special text step 100 to " . . . <b>bolded text</b> . . . ". A window title and a displayed article title are created in a create title step 102 that also adds top and bottom HTML tags to the file. Unused header information is then hidden by comment codes, and delimited with appropriate tags in a hide header step 104* (Column 5, lines 14 – 26), which provide that **the submitting means further comprises first means for translating said new document from a first data format to a second data format; first data format comprises a native word processor format and said second data format comprises a format compatible to said browser; second data format comprises a hypertext mark-up language (HTML) format.**

20. **Regarding dependent claims 10 - 12**, Myers et al. teach that *the primary computer 12 includes a CDROM drive 24 for receiving and inputting source disks 25 that may be periodically received from the provider 13. The computer 12 may also include a high-density disk drive 26 for writing processed counterparts of the received data on output disks 27 for delivery to the primary server 22A. It will be understood that the CDROM drive 24 and the high-density drive 26 can be a single device, and further that the processed data can be transmitted to the primary server 22A over the network 18* (Col. 3, lines 43 – 53), which provide for **a removable medium that is adapted to store said database and includes said means for searching said database, removable medium further comprises means for communicating with said server, communicating means comprises said browser**. Further, according to the Tiscali Reference <[www.tiscali.co.uk/reference/dictionaries/computers/data/m0045454.html](http://www.tiscali.co.uk/reference/dictionaries/computers/data/m0045454.html)>, “browser” is defined as *any program that allows the user to search for and view data*.

21. Claims 6, 7, 13 – 15, 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (US006374274B1) as applied to claims 1 – 5 and 8 – 12 above, and further in view of Alam et al. (US006336124B1).

22. **Regarding dependent claims 6 and 7**, Myers et al. do not explicitly teach **second means for translating ... or wherein said third data format comprises a format selected from the group consisting of conventional typesetting formats and conventional page layout formats**. However, Alam et al. does teach that *the present invention comprises a method for extracting data from digital data representing*



*a document, such as a printed document or of an Internet webpage. The method generally comprises locating words from the digital data of the document in the original or input format, joining the located words into lines, joining the lines into paragraphs, locating tables from the joined paragraphs, converting the paragraphs and tables to an intermediate format, and outputting the information into an output format. The input and output formats may be, for example, portable document format (PDF), rich text format (RTF), hypertext markup language (HTML) format ... formats generated by text and/or image authoring tools or applications, or any other suitable formats* (Column 1, lines 60 – 67, Column 2, lines 1 – 11), which provide for a **second means for translating said selected portion of said plurality of documents from said second data format to a third data format and wherein said third data format comprises a format selected from the group consisting of conventional typesetting formats and conventional page layout formats**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Alam et al. with Myers et al. because such a combination would give added flexibility to subscribers, thereby allowing them to publish articles in other formats for their authorized network clients.

23. **Regarding independent claims 13 and 18**, the claims incorporate substantially similar subject matter as claims 1 – 7, and are rejected along the same rationale.

24. **Regarding dependent claims 14 and 15**, the claims incorporate substantially similar subject matter as claims 1 – 7, and are rejected along the same rationale.

25. **Regarding dependent claim 19**, Myers et al. teach that *the convert article step 70 first finds and replaces embedded tags of the current raw article file with*

*corresponding HTML commented tags in a convert tags step 98. Text that is delimited with special characters is located, and corresponding HTML delimiters are substituted therefor in a special text step 100. Particularly, bolded text in the raw ASCII files is delimited by brackets (" . . . [bolded text] . . . "), being changed by the special text step 100 to " . . . <b>bolded text</b> . . . ". A window title and a displayed article title are created in a create title step 102 that also adds top and bottom HTML tags to the file. Unused header information is then hidden by comment codes, and delimited with appropriate tags in a hide header step 104 (Column 5, lines 14 – 26). Myers et al. do not explicitly teach a **look-up table**. However, it would have been obvious to one of ordinary skill in the art to interpret the teaching as providing a **first code subsegment for inspecting said new document for special characters; a look-up table storing a plurality of symbols in a plurality of codes representing said special characters; a second code subsegment for looking up in said look up table and comparing same to determine if said new document contains one or more special characters corresponding to said plurality of symbols stored therein; a third code subsegment for translating said one or more special characters into a standardized code; a fourth code subsegment for inserting said translation into said new document; and a fifth code subsegment for mapping said new document with said translation inserted therein to a new file in said database,** since a look-up table is well-known in the art and a *document anchor step 110 establishes a document target name at the top of the file in HTML format, and extracts**

*external target articles and artwork using the linkmap and docmap files, and imbeds corresponding HTML links (Column 5, lines 37 – 40).*

26. **Regarding dependent claim 20**, Myers et al. teach that *a principal feature of the present invention is that the primary computer 12 is implemented for automatically customizing selected documents of the provider to identify the subscriber, and optionally the client, and reformatting the selected documents to facilitate navigation therein by the subscriber's clients (Column 3, lines 36 – 41), which is providing a draft center for collaborative use by a plurality of authors prior to submitting a new document to said system.*

27. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (US006374274B1) and Alam et al. (US006336124B1) as applied to claims 6, 7, 13 – 15, 18 – 20 above, and further in view of Ivanov (US005706452A).

28. **Regarding dependent claim 16**, neither Myers et al. nor Alam et al. explicitly teach **assigning a plurality of peer reviewers to review said new document ... and notifying said plurality of peer reviewers ...** However, Ivanov teaches that *the workflow manager of Fig. 2 uses global variables in order to assign reviewers from a pool (Col. 33, lines 11 – 18), that documents to be reviewed are prepared by a set of preparers, and are stored into a database and a set of reviewers is notified that the document is ready for their review ... via electronic mail (Abstract), and that the invention allows concurrent access to shared data from a multitude of locations (Col.5, lines 19 – 20), which provide for assigning a plurality of peer reviewers to review*

**said new document, said plurality of peer reviewers being located at a third location displaced remotely from said one location and said other location; and notifying said plurality of peer reviewers through said network that said new document is available for review.** It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ivanov with Alam et al. and Myers et al. because such a combination would *allow one to define efficient document evaluation strategies that take advantage of the inherent parallelism within a business process* (Abstract).

29. **Regarding dependent claim 17**, Ivanov teaches that *workflow manager 30 translates workflow graph description 40 into an internal representation, which is stored in the memory of server computer 24, and is well suited for processing each document 44 and its associated reviews 46. A schematic of the internal representation of workflow graph 52 is presented in FIG. 8 (Column 18, lines 38 – 43), which provide for associating a review and grading form to said new document.* Ivanov teaches that *each role 48 can specify its own notification template. The body of the notification can specify, for example, which are the aspects of document 44 that need to be reviewed and which form to be used to compose review 46. In addition, the notification can provide some details from the document itself. FIG. 7G illustrates the notification obtained by expanding notification template in FIG. 7F for a particular document (Column 18, lines 15 – 22), which provide for sending a copy of said associated form and said new document to each of said plurality of peer reviewers.* Ivanov teaches that *the data components of review 46 (stored in the review itself) comprise ... rank*

*information (.sub.-- grd). The reviewer can assign a grade to document 44 to grade the aspects under consideration (Column 11, lines 23 – 28), which is a **providing means in said associated form for said plurality of peer reviewers to enter their grades and comments and collecting said associated form from each of said plurality of peer reviewers**. Ivanov also teaches that *both the Approval and the Rejection notifications are sent to the preparer and originate from the administrator. The subject line clearly identifies the document and its status. The body of each notification displays information from the proposal itself. If the proposal is rejected the justification entered by reviewer(s) is also displayed in the Rejection notification (Column 27, lines 45 – 50), which is a **providing means in an editor center to make decisions regarding publication of said new document**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ivanov with Alam et al. and Myers et al. because such a combination would *allow one to define efficient document evaluation strategies that take advantage of the inherent parallelism within a business process (Abstract).***

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
**JOSEPH H. FEILD**  
**PRIMARY EXAMINER**

NH